

REMARKS

Claims 12-24 are pending. By this Amendment, no claims are cancelled, claims 12, 13, 14, 16, 18, 19, 20, 21, 23, and 24 are amended and new claim 25 is added.

Response To Arguments and Interview Summary

Applicant acknowledges the Examiner's withdrawal of the rejections to claims 18 and 24 under 35 U.S.C. § 112, first paragraph.

The Examiner further indicated that Applicant's arguments with respect to the 35 U.S.C. § 112, second paragraph rejections have been considered but are not persuasive. Applicant thanks the Examiner for his time and courtesy in the brief telephone discussion of May 20, 2010, in which Applicant's representative attempted to clarify understanding of the claim term "non-sequential" and suggested amendments that the Examiner indicated should overcome the rejection under 35 U.S.C. § 112, second paragraph. The claims herein have been amended accordingly.

Claim Objections

The Office Action objected to claims 13, 14 and 18 under 37 C.F.R. 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim. The Office Action continues "these claims recite functions of the pulse picking device, deflecting device and control device that do not further modify these elements or necessarily require a new element to perform the claimed functions." While not acquiescing to the objection, to advance prosecution, Applicant has herein amended claims 13, 14 and 18. For example, claim 13 has been amended to recite:

wherein the laser pulses of the train of laser pulses are substantially equidistant in time and wherein the control device is programmed to operate the pulse picking device such that the pulse picking device selects non-consecutive laser pulses of the train of laser pulses, the selected laser pulses being substantially equidistant in time according to a selection frequency.

Accordingly, Applicant respectfully requests that the Examiner withdraw the objection.

35 U.S.C. § 112

The Office Action rejected claims 12 and 19 under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. The Office Action then continues “the control device is critical or essential to the practice of the invention but not included in the claims and cites *In re Mayhew*”. Applicant respectfully traverses the rejection. The aspects of the invention recited in claims 12 and 19 are described and enabled throughout the application as filed. Enabling disclosure can be found at, for example, from Page 3, Line 33 to Page 6, Line 5 as well as in figs. 5-7 and Page 8, Line 1 thru Page 10, Line 16.

Further, according to the MPEP 2172.01, a claim which omits matter disclosed *to be essential to the invention as described in the specification or in other statements of record* may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Nowhere in the specification or the record has the Applicant stated that “the control device is critical or essential.” The second paragraph of § 112 dictates that the claims describe “the subject matter that *the applicant* regards as his invention. Accordingly, an element of the invention is only considered critical or essential if the Applicant

states that it is. The Applicant has made no such statement here. Therefore the rejection is improper. Applicant respectfully requests that the Examiner withdraw the rejection.

While not acquiescing to the rejection, Applicant has amended claims 12 and 19 without prejudice, disclaimer or waiver of subject matter. Applicant respectfully requests that the Examiner withdraw the rejection.

The Office Action rejected claims 13, 18, 20 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action then indicates “see explanation in the Response to Argument section supra and in the former NFOA.”

While not acquiescing to the rejection, Applicant has amended the rejected claims and believes that the amended claims fully comply with the dictates of 35 U.S.C. § 112.

The Office Action also rejected claim 13 on the basis of the claim term “selection frequency.” By this amendment Applicant has amended the claims that recite the term “selection frequency” in response to the Examiner’s concerns. Applicant respectfully requests that the Examiner withdraw the rejection.

Claim Rejections – 35 U.S.C. § 103

The Office Action rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Swinger et al. (U.S. 6,325,792). By this Amendment, Applicant has amended claim 12 to recite:

a source of laser radiation providing pulsed laser radiation comprising a train of laser pulses; and

a deflecting device, which directs said laser radiation into the material at different, selectable locations to generate optical breakthroughs within the material; and

a pulse picking device that modifies selected laser pulses of the train of laser pulses, with regard to at least one optical parameter of said selected laser pulses, such that the selected laser pulses cannot generate optical breakthroughs; and

a control device that controls the operation of the pulse picking device such that the pulse picking device influences said selected laser pulses such that only a remaining subset of not selected laser pulses cause optical breakthroughs within the material

The Swinger references do not disclose or suggest all of the limitations of claim 12. In particular, Swinger does not disclose or suggest “a pulse picking device that modifies selected laser pulses of the train of laser pulses with regard to at least one optical parameter of said selected laser pulses.” Column 17, Lines 40-49 only states “Referring again to FIG. 6, the laser beam B passes through a beam intensity controller 112, the output of which is the surgical laser

beam S. The beam intensity controller 112 permits regulation of the energy of each laser pulse so that the etch depth of each pulse may be precisely controlled.” Swinger does not disclose or suggest “a pulse picking device.” Accordingly, claim 12 as amended should be patentable over the Swinger reference.

By this Amendment, Applicant has amended claim 19 to recite:

generating pulsed laser radiation comprising a train of laser pulses via a laser source controlled by a control unit;

variably deflecting the pulsed laser radiation into the material to generate optical breakthroughs within the material; and

modifying selected laser pulses of the train of laser pulses, with regard to an optical parameter of said selected laser pulses, such that the selected laser pulses no longer generate optical breakthroughs, wherein only a remaining subset of not selected laser pulses cause optical breakthroughs within the material.

The Swinger reference also does not disclose or suggest all of the limitations of claim 19.

In particular, Swinger does not disclose or suggest at least:

modifying selected laser pulses of the train of laser pulses, with regard to an optical parameter of said selected laser pulses, such that the selected laser pulses no longer generate optical breakthroughs, wherein only a remaining subset of not selected laser pulses cause optical breakthroughs within the material

for the same reasons discussed above with relation to claim 12.

Accordingly, independent claims 12 and 19 should be patentable for at least these reasons. Claims 13-18 depend from claim 12 and should be patentable for at least the same reasons as claim 12. Claims 20-24 depend from claim 19 and should be patentable for at least the same reasons as claim 19.

Claim 14

Claim 14 recites in part that “the pulse picking device modifies the selected laser pulses at least with regard to one parameter selected from a group consisting of phase, amplitude, polarization, propagation direction and beam profile.” Swinger does not disclose or suggest altering these parameters of selected laser pulses. Accordingly, claim 14 should be patentable for at least this additional reason.

The Office Action also rejected claims 19-21 “as an obvious use of the modified Swinger reference.” The Office Action continues that the

method as claimed are obvious steps during the normal use and operation of the modified Swinger reference, since the apparatus includes all of the structural limitations as discussed *supra*. In other words, the steps as claimed are not germane to the issue of patentability over a prior art device itself, because to be entitled to weight in the method claims, the recited structural limitations therein must effect a method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure.

Applicant respectfully traverses the rejection and respectfully submits that the above recitation in the Office Action does not establish a prima facie case of obviousness with regard to claims 19-21. To make-out a prima facie case of obviousness, the Office Action must present evidence that each and every limitation of the claim is disclosed in the prior art reference. As discussed above, the Swinger reference does not disclose each and every limitation of claim 19, accordingly, the Swinger reference cannot render obvious the steps of claim 19.

Further, according to the Supreme Court opinion in *KSR v. Teleflex*, the Office Action must present some reasoning or rational underpinning to support the legal conclusion of obviousness. The conclusory statement that “claims 19-21 are rejected as an obvious use of the modified Swinger reference” does not provide the required reasoning or underpinning to support a conclusion of obviousness. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

Further, with regard to claims 18-24, the Office Action admits that “using this approach to regulate the deflection speed is not specifically taught.” Accordingly, all of the limitations of claims 18-24 are not disclosed or suggested by Swinger for this additional reason and the Office Action does not make a prima facie case of obviousness with regard to claims 18-24. Applicant respectfully requests that the Examiner withdraw the rejection.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Onderick', with a long horizontal flourish extending to the right.

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